

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments may be found in the specification, for example, on page 17 line 3 to page 19 line 4 and FIG. 5, as originally filed. Thus, no new matter has been added.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1, 2, 4-10, 12, 13 and 15-23 under 35 U.S.C. §103(a) as being unpatentable over Marpe et al. (hereafter Marpe), US Pub. No. 2005/0074176 in view of Wiegand et al. (hereafter Wiegand), document "Joint Video Team (JVT) of ISO/IEC MPEG & ITU-T VCEG", 8th Meeting, Geneva, Switzerland, May 2003 has been obviated by amendment and should be withdrawn.

Marpe concerns coding of a syntax element contained in a pre-coded video signal (title). Wiegand concerns a recommendation and final draft international standard of Joint Video Specification (title).

Claims 1, 12 and 20 are independently patentable over the cited references. Claim 1 provides that a neighbor condition comprises (i) a first of the neighbor blocks having an unavailable macroblock address, (ii) a second of the neighbor blocks having an

intra-prediction mode of a plurality of prediction modes, (iii) a third of the neighbor blocks having a skip mode of the prediction modes and (iv) a reference index zero flag having a non-zero condition and (v) a prediction mode flag having a zero condition. Claims 12 and 20 provide similar language. In contrast, both Marpe and Wiegand appear to be silent regarding a prediction mode flag having a zero condition, as presently claimed. Therefore, *prima facie* obviousness has not been established.

Claim 1 further provides that the prediction mode flag has the zero condition where (i) a fourth of the neighbor blocks is sub-partitioned and has a sub-macroblock prediction mode that is not an inter-prediction mode of the prediction modes and not a bi-directional prediction mode of the prediction modes. Claims 12 and 20 provide similar language. In contrast, both Marpe and Wiegand appear to be silent regarding a neighbor block that is sub-partitioned and has a sub-macroblock prediction mode that is not an inter-prediction mode of the prediction modes and not a bi-directional prediction mode of the prediction modes, as presently claimed.

Furthermore, the present invention was submitted to the Joint Video Team (JVT) which subsequently incorporated the invention into the H.264/AVC (Advanced Video Coding) documentation. See the International Organization for Standardization/International Electrotechnical Commission 14496-10 standard and an

International Telecommunication Union-Telecommunications Revised Recommendation H.264(E):2005, "Advanced video coding for generic audiovisual services", February 28, 2005, paragraphs 9.3.3.1.1.6 and 9.3.3.1.1.7. (reproduced in Appendix A). The incorporation of the invention into the ISO/IEC H.264/AVC recommendation by the JVT is in itself evidence of commercial success under *Graham v. John Deere Co.*

At the time of invention, one of ordinary skill in the art would have been likely to comply with the draft H.264/AVC recommendation that was available at that time. One of ordinary skill in the art would have done so to maintain interoperability with the works of others in the same field. Non-compliance with the H.264/AVC recommendation would have been unexpected. Any digital video decoded (or encoded) by a non-compliant technique would not have been commercially viable as the resulting decompressed video (or compressed bitstream) would have been distorted relative to compliant decoders (or encoders). Therefore, operational deviations away from the H.264/AVC recommendation would have been non-obvious at the time of the invention. As such, the claimed invention is fully patentable over the cited references and the rejections should be withdrawn.

Claims 2, 4-10, 13, 15-19 and 21-23 depend from claims 1 and 12, which are now believed to be allowable. As such, the

dependent claims are fully patentable over the cited references and the rejections should be withdrawn.

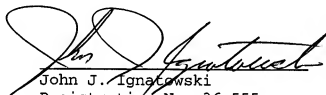
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative between the hours of 9 a.m. and 5 p.m. ET at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

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